

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

JUN 07 2004

In re Application of

VES MALECOT ET AL

U.S. Serial No. 09/744,946

Group Art Unit 1723

Filed: February 8, 2001

M. Ocampo, Examiner

FILTERING ELEMENT MADE OF ABSORBENT PAPER MATERIAL IN THE FORM OF A TUBULAR CYLINDER

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

Transmitted herewith is ~~an amendment~~ / a response after final rejection in the above-identified application.

☒ No additional fee is required.
☐ An additional fee is required as calculated below -

Claims Remaining After Amendment	Highest No. Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Add'l Fee	Rate	Add'l Fee
Total	Minus *		x \$ 9	\$	x \$18	\$
Indep	Minus *		x \$43	\$	x \$86	\$
First Presentation of Mul Dep Claim....			x\$145	\$	x\$290	\$
Total Additional Fee.....			\$		\$	

* The "Highest Number Previously Paid For" (Total or Independent) is the highest number of claims filed originally or highest number found from equivalent box of a prior amendment.

☐ This response is being filed within the period for response.

☒ Applicant(s) hereby petition for an extension from the date of the Examiner's Action as follows:

☐ First-Month Extension..... \$ 55.00 / \$ 110.00
☐ Second-Month Extension..... \$ 210.00 / \$ 420.00
☒ Third-Month Extension..... \$ ~~475.00~~ / \$ 950.00

☐ Small entity status of this application has been established.

A Check in the amount of \$ 950.00 is attached hereto. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 02-3690 of the undersigned attorney. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

Date: June 7, 2004
(703) 684-6885

By Mary Brainer
Attorney of Record, Reg. No. 33,161



5418/tat

"PATENT APPLICATION"

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Alexandria, Virginia
June 7, 2004

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P.O. Box 1450
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R E S P O N S E

Dear Sir:

This is in response to the official action mailed January 5, 2004. Applicants have considered the outstanding official action and respectfully submit that the claimed invention is patentable over the cited art as set forth below.

The outstanding rejections based on prior art are as follows:

- (1) Claims 13-15, 18-21 and 25 under 35 U.S.C. §103(a) over U.S. Patent No. 4,454,036 (Suzuki) in view of U.S. Patent No. 2,512,797 (Harvuot);
- (2) Claims 13-21 and 25 under 35 U.S.C. §103(a) over Suzuki in view of Harvuot and U.S. Patent No. 4,487,378 (Kobayashi); and

- (3) Claims 22-23 under 35 U.S.C. §103(a) over Suzuki, Harvuot and Kobayashi as applied above to claim 13 and further in view of British Application No. 2,150,456 (Whiteside).

The pending claims are 13-23 and 25 wherein claim 13 is the sole independent claim.

Claim 13 claims a filter element including

- absorbent tissue paper material in sheet form compactly wound to form inner winding turns therein and to constitute a tubular cylinder,
- fluid being able to move across the filter element in a substantially centripetal direction;
- the filter element being devoid of a core; and
- the inner winding turns having a contour which prevents the inner winding turns from unraveling inward.

These structural features, in particular in combination, are not rendered obvious by the applied art within the meaning of §103. The basic references applied in each rejection are Suzuki and Harvuot. Each of these references fail to teach or suggest certain claimed features or require the presence of other features which are inconsistent or teach away from the claimed invention.

Most notably as to Suzuki, Suzuki does not describe absorbent tissue paper in sheet form compactly wound or that fluid can move across the described filter element in a substantially centripetal direction and, as acknowledged by the Examiner, Suzuki does not teach a filter element devoid of a central core.

As disclosed in Suzuki, at column 4, lines 5-7, "the oil flows into the oil path B from the lower end side of the element 1" Thus, even if a part of the direction of flow were diametrical, the outlet of the filter is thus axial which is contrary to the filter of the invention. This is confirmed since there is no opening along the surface of the central axis. As described at column 2, lines 45-50, the central core member 1b is made of thick paper, plastic or metal. Clearly, therefore, no fluid can pass through the core member.

Further, Suzuki does not teach the roll as being compactly wound as claimed by applicants. At page 6, paragraph 1, of the applicants' captioned application, it is stated that a compression roller is applied against the outside of the winding in progress and allows for especially compact winding. Suzuki does not teach or suggest compact winding, but rather teaches only conventional forming of wound paper on a core, i.e., the simple wrapping of a thin

sheet of water insoluble paper in the same manner as toilet paper. Toilet paper is not compactly wound so as to avoid crushing of the core and the paper in which a thickness or softness is desired. Such properties would be at least severely lessened if not removed from the paper if such was subjected to compact winding. Accordingly, Suzuki also does not teach compact winding as claimed.

Harvuot does not make up for the shortcomings of Suzuki. Upon combination of Suzuki and Harvuot, applicants' claimed invention would still not be provided. The filter taught by Harvuot is made of a paper which has been treated with a resin. Harvuot teaches that the filter is rigid, but the rigidity is due to the treatment with resin and not because of the sheet being compactly wound. Harvuot describes the manufacturing method used to obtain the filter. It is clearly different from the roll used in the filter of the invention. After impregnating the roll with resin, the rolls baked at a temperature of 250°F in order to obtain a rigid product. The filter described in Harvuot does not include any core because it includes sufficient internal rigidity due to the resin. The function of a core is fulfilled by the impregnated paper. See column 3, lines 22-27, ... "one or more wraps of impregnated paper may be used at the inner or outer surface of the cylinder as may be

required ... if higher pressures are to be used, the unit must be made more rigid and stronger".

Thus, the combination of teachings of Suzuki and Harvuot do not produce the filter of the invention. Based on the specific teachings of required features for the articles described to be useful for their intended functions, the roll of Suzuki requires a central core for support. Applying the teaching of Harvuot to Suzuki implies the use of support provided by the resin in Harvuot. In the invention it is the compact roll combined with a contour of the inner surface of the roll that provides the required support.

Thus, one skilled in the art would not obtain the claimed invention from a combination of the teachings of Suzuki and Harvuot. Substitution of the filter of Harvuot in an oil filter as described in Suzuki would not result in a filter element of absorbent tissue paper devoid of a core member compactly wound and allowing fluid to move across the filter in a substantially centripetal direction. Accordingly, the combination of Suzuki and Harvuot is deficient in teaching and suggestion with respect to the combined structure of the claimed invention.

The secondary references of Kobayashi and Whiteside do not make up for the shortcomings of Suzuki and Harvuot.

Kobayashi teaches making a compactly wound roll of tissue paper. However, there is no teaching or suggestion in any of Suzuki, Harvuot or Kobayashi that such would be suitable as a filter element. Each of Suzuki and Harvuot teach required structural elements to meet the disclosed purpose of a filter element which are inconsistent with the teachings of Kobayashi. Accordingly, the roll of Kobayashi would be modified to meet the requirements of Suzuki or Harvuot, or one skilled in the art would not even look to Kobayashi in view of the difference in use and structure.

Whiteside is applied with respect to an additional limitation in dependent claims. Whiteside also does not make up for the shortcomings of Suzuki, Harvuot and Kobayashi. Whiteside is not directed to a coreless filter element of a compactly wound absorbent tissue paper devoid of a core and allowing for movement of fluid in a centripetal direction across the filter element. Whiteside teaches an oil filter having a filter element surrounding a central core integral with and projecting upward from the base. The core structure is critical to Whiteside's teaching of a fluid flow in a direction parallel to the axis

of the filter. Whiteside would not be useful for its intended purpose without a central core and such intended purpose does not provide for a centripetal fluid flow.

The Court of Appeals for the Federal Circuit in In re Dow Chemical Co., 5 USPQ2d 1529 at 1531 (Fed. Cir. 1988), stated:

"The consistent criterion for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. [References omitted]. Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure.

In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

Deficiencies in the factual basis cannot be supplied by resorting to speculation or unsupported generalities. In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967) and In re Freed, 425 F.2d 785, 165 USPQ 570 (CCPA 1970).

Further, the mere fact that the prior art can be modified does not make the modification obvious unless the prior art suggests the desirability of the modification. In re Gordon, 733 F.2d 900, 902; 221 USPQ 1125 (Fed. Cir. 1984). Once applicants' solution to a problem is disclosed, it is easy to see how prior references can be modified and

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manipulated to produce the claimed invention. The change can appear simple and by hindsight seem obvious. However, as stated by the Court in In re Sporck, 133 USPQ 360, 363 (CCPA 1962), the simplicity of new inventions is oftentimes the very thing that is not obvious before they are made. The Court goes on to cite as support In re Osplack, 195 F.2d 921, 93 USPQ 306, 308 stating -

"We think this case is one of that category of inventions which, when viewed after disclosure and explanation by an applicant, seem simple and such as should have been obvious to those in the field. Yet this does not necessarily negative invention or patentability. [citations omitted]. Indeed, simplicity may even be some evidence of invention. [citations omitted]."

The final rejection of the Primary Examiner makes it clear that the Examiner is selecting select parts of the prior art disclosures based on applicants' own teaching. This is using improper hindsight. Thus, as the Court of Appeals for the Federal Circuit stated in In re Rouffet, 47 USPQ2d 1453 (Fed. Cir. 1998):

"As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner

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to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570. 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed."

In the case at hand, there is no motivation to pick and choose only select parts from a plurality of references as applied by the Examiner.

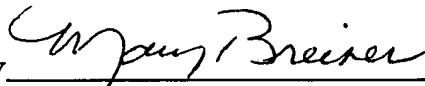
Accordingly, applicants respectfully submit that none of the applied combinations of art teach or suggest the claimed invention within the meaning of 35 U.S.C. §103. Withdrawal of the §103 rejections are therefore respectfully requested.

Reconsideration and allowance of the claims is respectfully urged.

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Respectfully submitted,

YVES MALECOT ET AL

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